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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,933	12/10/2003	Allan Grainger	3003-1088-1	7168
466	7590	04/11/2006	EXAMINER	
NOVOSAD, JENNIFER ELEANORE				
ART UNIT		PAPER NUMBER		
3634				

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/730,933	GRAINGER, ALLAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer E. Novosad	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 December 2003 and 21 March 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 12-24, 26 and 27 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11, 25 and 28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 December 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 10/730,933.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

This Office action is in response to (a) the application filed December 10, 2003, (b) the election and amendment filed January 5, 2006 by which claims 1 and 9-11 were amended and claim 28 was added, and (c) the election filed March 21, 2006 (which was in response to the non-responsive amendment mailed March 1, 2006).

### ***Election/Restriction***

Applicant's election with traverse of Group I, i.e., claims 1-25, species (b), i.e., Figures 6, 7, and 10, and sub-species (ii), i.e., Figure 9, in the replies filed on January 5, 2006 and March 21, 2006 is acknowledged. The traversal is on the following grounds:

- (a) "The different devices disclosed... are not separate inventions at all but rather are species of the same invention."
- (b) "Claim 1 no longer specifies that the members ... are clamping members... Instead, the recitation of these members is now broad enough to read on the members 58 of claim 26."
- (c) "There is thus not even one-way distinctness between the groups, much less two-way distinctness."
- (d) "Separate classification is no evidence of the propriety of a requirement for restriction."
- (e) "The search field for either inventions... would require a search through... both subclasses, because they represent genus and species."

This is not found persuasive for the following reasons.

*Firstly, with respect to (a),* it is unclear to the examiner what applicant is intending to argue. *In particular,* there is both separate inventions and species present in this application. *With respect to (b),* applicant's amendment to claim 1 does not overcome the restriction requirement previously set forth. Although applicant has deleted the word "clamping" from claim 1, claim 26 still lacks any corresponding element. *Thus,* a search for the feature of the members (i.e., clamping) of claim 1 would not necessarily give way to a search of the apparatus of claim 26. *Thus,* the invention of claim 1 is distinct from the invention of claim 26 and restriction is therefore proper.

*With respect to (c),* as advanced above, one-way distinctness has been shown, i.e., the invention of claim 26 has separate utility such as use without the members of claim 1. Regarding applicant's statement of "two-way" distinctness, the examiner need not show two-way distinctness for the restriction to be proper.

*Regarding (d) and (e),* as shown in the restriction requirement (see page 2 of the requirement mailed on December 8, 2005), separate classification is part of a proper restriction. Applicant has failed to adequately show that restriction is improper, and although a search of both subclasses may be made for both inventions, as advanced above, the search for the invention of claim 1 is not necessarily needed for that of claim 26.

It is noted that applicant has indicated that claims 1-12 and 25 (see the reply filed March 21, 2006) read on the embodiment. *However,* the examiner respectfully disagrees. *Firstly,* claim 12 does not read on the elected embodiment but rather reads on the figures of species (a). *Secondly,* claim 28 reads on the elected embodiment.

*Thus, claims 12-24, 26, and 27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, species, and sub-species, there being no allowable generic or linking claim. Claims 1-11, 25, and 28 have been examined on the merits.*

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the (a) gate member protruding "into the path of the pallet", as in each of claims 4-8, and (b) the clamping member being located "parallel" to the rails, as in claim 11, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. *It is noted that the figures, especially Figure 7, shows the gate member (21) parallel to the front of the pallet and pivoted "away" therefrom, i.e., the drawings do not show the gate member extending "into" the path of the pallet.*

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in United Kingdom on December 10, 2003. It is noted, however, that applicant has not filed a certified copy of the British application as required by 35 U.S.C. 119(b).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The positive recitations "to receive" and "to engage" in lines 4 and 7, respectively, of claim 1 (note also line 2 of claims 9, 11, and 28 and lines 2 and 6 of claim 10) render the claim indefinite. *In particular*, the metes and bounds of the claim cannot be properly ascertained since it is unclear whether the pallet is being positively required. If the pallet is not being positively required in the claim, then --adapted-- should be inserted before these recitations in lines 4 and 7 (and also the applicable lines of claims 9-11 and 28). The claim has been examined as though the subcombination, i.e., of just the apparatus, is being claimed.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural

cooperative relationships are: between the rails and members, i.e., it is unclear to what structure the members are connected.

Claim 1 recites the limitation "the support" in line 10. There is insufficient antecedent basis for this limitation in the claim. This rejection is also applicable to lines 5-6 of claims 2 and 3; lines 3 and 5 of claim 4; lines 3, 5, and 8 of claim 5; lines 3 and 5 of claim 6; lines 3, 5, and 7 of claim 7; and line 3, 5, and 8 of claim 8.

The recitation "from that normally used" in line 10 of claim 1 renders the claim indefinite since it is unclear what defines "that".

The recitation "the stop is approximately equal in width to a pallet" in lines 6-8 of claim 1, renders the claim indefinite. *In particular*, a pallet is not an element of the claimed device and it is improper to seek to define claimed structure based on a comparison to some unclaimed element. In this case, the boundaries of the claim cannot be properly ascertained because one would not know whether their device infringed the instant claim until someone else later added a pallet. In other words, a device as defined in the claims would infringe the claim with one particular pallet while the exact same device would not infringe the claim when another pallet is used. *Accordingly*, the features of the device, itself, must be defined instead of relying upon a comparison with an ascertained element.

Regarding claim 5 (see line 7), the word "means" is preceded by no word(s) in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation "one or more gate members" in line 2, and the claim also recites "a pair of gate members" in line 6 which is the narrower statement of the range/limitation.

Claim 6 recites the limitation "the gate member" in line 8. There is insufficient antecedent basis for this limitation in the claim. It is noted that line 2 sets forth "one or more" and line 6 sets forth a "pair", so it is unclear which gate member is being referenced in line 8.

Claim 7 recites the limitation "the entire height" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 8 (see line 7), the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The use of the term "can" in line 8 of claim 8 renders the claim indefinite since it is unclear whether the claim is positively requiring the function proceeding this term or not and thus the metes and bounds of the claim cannot be properly ascertained.

The recitation "the path" lacks proper antecedent basis in each of claims 4-8.

Claim 28 is rendered indefinite since it is unclear what structure is being required by the claim. *In particular*, claim 1 sets forth "one or more" members and then claim 28 recites "said members". Thus, since a reference need show only "one" member in order to meet the language of claim 1, it is unclear, from the language of claim 28, if more than one member is being required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 25, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,735,661 (De Frondeville et al. '661).

*Insomuch as the claims are best understood (especially in view of the Section 112, 2<sup>nd</sup> paragraph rejections, advanced above), De Frondeville et al. '661 disclose an apparatus comprising two parallel opposed substantially horizontal rails (41) spaced and receiving a pallet (30n) therebetween; one member (37 on right of Figure 13 and at lower right hand corner of Figure 8), i.e., with respect to claims 9-11, member is considered to define a "clamping"*

member, adapted to engage an upper surface of the pallet; a stop (37 - lowest element on left hand side of Figure 8) adjacent one of the rails (41) near an end of the apparatus remote from the loading end (top right hand corner of Figure 8); *with respect to claims 2-4*, the stop (37 - lowest element on left hand side of Figure 8) includes an elongate plate (see Figure 7) having a substantially vertical portion and a transverse portion perpendicular to the vertical portion and extending towards the loading end (top right hand corner of Figure 8) whereby the width of the stop is approximately equal to the width of the pallet; *with respect to claims 4-8*, the apparatus including one gate member (37 - top element on right side of Figure 8, i.e., second element 37 from the bottom of Figure 8) located *near* the loading end (top right hand corner of Figure 8) and being movable between a locking position (solid lines in Figure 16) where it protrudes into the path of the pallet *near* the loading end (top right hand corner of Figure 8) and a release position (dotted lines in Figure 16); whereby *with respect to claim 5*, the gate member is clear of the path whereby the gate is movable by a pivot (71 - see Figures 7 and 16); whereby *with respect to claim 6*, the gate member includes an angle bracket (see Figure 7) having a second portion substantially perpendicular to a first position; whereby *with respect to claim 7*, the gate member extends *substantially* along the height of the apparatus; whereby *with respect to claim 8*, the gate member is fitted with a locking mechanism (at 36); *with respect to claims 9-11*, the member can be moved to a locking position about a pivot (71 - see Figures 7 and 16); *with respect to claim 10*, the member includes an arm including a clamp (72) that can be adjusted (the clamp 72 pivots or rotates) to contact an upper surface of the pallet; and *with respect to claim 11 (insomuch as this feature is not shown in the drawings)*, the member is located parallel, i.e., the bottom portion

(at 62 in Figure 16) extends in a direction that is substantially parallel to the length of the rails, to the rails (41).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is 571-272-6832. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer E. Novosad  
Primary Examiner  
Art Unit 3634

April 10, 2006